

Application No.: 10/774,666
Office Action Dated: November 22, 2005
Response to Office Action with Extension of Time Dated: March 22, 2006

AMENDMENT TO THE DRAWINGS

In response to the Examiner's objections to the drawings, the Applicant has submitted replacement drawings that comply with 37 C.F.R. 1.84 and 1.121. The replacement drawings are submitted herewith.

REMARKS

The Office Action dated November 22, 2005 presents the examination of claims 1-20. Claim 10 has been amended to provide proper antecedent basis. No new matter is inserted into the claims.

Objection

The Examiner objects to the drawings as not showing every feature of the invention specified in the claims. They have been amended and should now be allowable. Specifically, Figure 5 has been amended to show the "substantially discontinuous concave surface" and the substantially non-continuous concave surface." Support for this amendment can be found in Paragraph 23 of the specification. No new matter is inserted.

Rejection under 35 U.S.C. § 112, second paragraph of Claims 10-16

The Examiner rejects Claims 10-16 under 35 U.S.C. § 112, second paragraph, as being indefinite since "said concave inner surface" has insufficient antecedent basis in claim 10. Applicant has amended the claim, and the claims should now be allowable.

Rejection under 35 U.S.C. § 102(b) of Claims 1-2 and 10-11 based on Moss et al.

The Examiner rejects claims 1-2 and 10-11 under 35 U.S.C. § 102(b) for allegedly being anticipated by Moss et al. Applicant respectfully traverses the rejection applied to the pending claims. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

Moss et al. discloses an extractor comprising a breech-plate having a plurality of arms extending radially outward from an inner portion of the plate. However, Applicant respectfully submits that Moss et al. does not teach an inner surface having an arc length that is greater than one-half the circumference of a cartridge disposed within the cylinder bores of the revolver. Neither the specification nor the drawings of Moss et al. disclose this claim element.

According to MPEP 2125, when “the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value.” See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (“[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.”). Since the drawings shown in Moss et al. are not said to be drawn to scale, they do not define whether the arc length is one-half the circumference of a cartridge disposed within the cylinder bores of the revolver, and thus, they are incapable of disclosing this element in the claims.

Therefore, Moss et al. fails to anticipate the present invention under 35 U.S.C. § 102(b). Withdrawal of the instant rejection is therefore respectfully requested.

Rejection under 35 U.S.C. § 103(a) of Claims 3 and 12 over Moss et al.

The Examiner rejects claims 3 and 12 under 35 U.S.C. § 103(a) for allegedly being obvious over Moss et al. Applicant respectfully traverses the rejection applied to the pending claims. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP 2143.03). As discussed above regarding the § 102 rejection, Moss et al. fails to teach or suggest an inner surface having an arc length that is greater than one-half the circumference of a cartridge disposed within the cylinder bores of the revolver.

Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

Rejection under 35 U.S.C. § 103(a) of Claims 4 and 13 over Moss et al. in view of Philips

The Examiner rejects claims 4 and 13 under 35 U.S.C. § 103(a) for allegedly being obvious over Moss et al. in view of Philips. Applicant respectfully traverses the rejection applied to the pending claims. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP 2143.03). As discussed above regarding the § 102 rejection, Moss et al. fails to teach or suggest an inner surface having an arc length that is greater than one-half the circumference of a cartridge disposed within the cylinder bores of the revolver. Combining Moss et al. with Philips does not remedy this failure.

Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

Rejection under 35 U.S.C. § 103(a) of Claims 5 and 14 over Moss et al. in view of Philips and further in view of *In re Boesch*

The Examiner rejects claims 5 and 14 under 35 U.S.C. § 103(a) for allegedly being obvious over Moss et al. in view of Philips and further in view of *In re Boesch*. Applicant respectfully traverses the rejection applied to the pending claims. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP 2143.03). As discussed above regarding the § 102 rejection, Moss et al. fails to teach or suggest an inner surface having an arc length that is greater than one-half the circumference of a cartridge disposed within the cylinder bores of the revolver. Combining Moss et al. with Philips does not remedy this failure.

Furthermore, Applicant respectfully submits that the Examiner has misstated the holding of *In re Boesch*. The Court held "that discovery of an optimum value of a result effective variable *in a known process* is ordinarily within the skill of the art"

(emphasis added). 205 USPQ 215, 219 (CCPA 1980). The Examiner has failed to show that finding an optimum angle for the beveled edge is a known process. Applicant submits that it is not a known process, and therefore, it would not be ordinarily within the skill of the art.

For the reasons given above, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

Rejection under 35 U.S.C. § 103(a) of Claims 6, 15, and 20 over Moss et al. in view of Mochak

The Examiner rejects claims 6, 15, and 20 under 35 U.S.C. § 103(a) for allegedly being obvious over Moss et al. in view of Mochak. Applicant respectfully traverses the rejection applied to the pending claims. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP 2143.03). As discussed above regarding the § 102 rejection, Moss et al. fails to teach or suggest an inner surface having an arc length that is greater than one-half the circumference of a cartridge disposed within the cylinder bores of the revolver. Combining Moss et al. with Mochak does not remedy this failure.

Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

Rejection under 35 U.S.C. § 103(a) of Claims 7 and 16 over Moss et al. in view of Mochak

The Examiner rejects claims 7 and 16 under 35 U.S.C. § 103(a) for allegedly being obvious over Moss et al. in view of Mochak. Applicant respectfully traverses the rejection applied to the pending claims. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP 2143.03). As discussed above regarding the § 102 rejection, Moss et al. fails to teach or suggest an inner surface having an arc length that is greater than one-half the circumference of a cartridge disposed within the cylinder bores of the revolver. Combining Moss et al. with Mochak does not remedy this failure.

Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

Rejection under 35 U.S.C. § 103(a) of Claim 8 over Mochak in view of Philips

The Examiner rejects claim 8 under 35 U.S.C. § 103(a) for allegedly being obvious over Mochak in view of Philips. Applicant respectfully traverses the rejection applied to the pending claim. Reconsideration of the claim and withdrawal of the instant rejection are respectfully requested.

Applicant submits that the Examiner has used impermissible hindsight. According to MPEP 2142, "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." The Examiner's statement that it would have been obvious to combine Mochak in view of Philips is merely conclusory and provides no factual basis for the modification.

Applicant respectfully submits that none of the cited prior art, alone or in combination, suggest the claimed invention absent motivation provided through impermissible hindsight.

As there is no motivation to combine the disclosures of Mochak and Philips, Applicant respectfully submits that for at least this reason, claim 8 is allowable over these references.

Rejection under 35 U.S.C. § 103(a) of Claim 9 over Mochak in view of Philips and further in view of *In re Boesch*

The Examiner rejects claim 9 under 35 U.S.C. § 103(a) for allegedly being obvious over Mochak in view of Philips and further in view of *In re Boesch*. Applicant respectfully traverses the rejection applied to the pending claims. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

Applicant submits that the Examiner has used impermissible hindsight. According to MPEP 2142, "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." The Examiner's statement that it would have been obvious to combine Mochak in view of Philips is merely conclusory and provides no factual basis for the modification.

Applicant respectfully submits that none of the cited prior art, alone or in combination, suggest the claimed invention absent motivation provided through impermissible hindsight.

As there is no motivation to combine the disclosures of Mochak and Philips, Applicant respectfully submits that for at least this reason, claim 9 is allowable over these references.

Furthermore, Applicant respectfully submits that the Examiner has misstated the holding of *In re Boesch*. The Court held "that discovery of an optimum value of a result effective variable *in a known process* is ordinarily within the skill of the art" (emphasis added). 205 USPQ 215, 219 (CCPA 1980). The Examiner has failed to show that finding an optimum angle for the beveled edge is a known process. Applicant submits that it is not a known process, and therefore, it would not be ordinarily within the skill of the art.

For the reasons given above, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

Rejection under 35 U.S.C. § 103(a) of Claims 17 and 18 over Moss et al. in view of Philips in view of Mochak and further in view of *In re Boesch*

The Examiner rejects claims 17 and 18 under 35 U.S.C. § 103(a) for allegedly being obvious over Moss et al. in view of Philips in view of Mochak and further in view of *In re Boesch*. Applicant respectfully traverses the rejection applied to the pending claims. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP 2143.03). As discussed above regarding the § 102 rejection, Moss et al. fails to teach or suggest an inner surface having an arc length that is greater than one-half the circumference of a cartridge disposed within the cylinder bores of the revolver. Combining Moss et al. with Philips and Mochak does not remedy this failure.

Furthermore, Applicant respectfully submits that the Examiner has misstated the holding of *In re Boesch*. The Court held “that discovery of an optimum value of a result effective variable *in a known process* is ordinarily within the skill of the art” (emphasis added). 205 USPQ 215, 219 (CCPA 1980). The Examiner has failed to show that finding an optimum angle for the beveled edge is a known process. Applicant submits that it is not a known process, and therefore, it would not be ordinarily within the skill of the art.

For the reasons given above, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

Rejection under 35 U.S.C. § 103(a) of Claim 19 over Moss et al. in view of Philips in view of Mochak and further in view of *In re Boesch*

The Examiner rejects claim 19 under 35 U.S.C. § 103(a) for allegedly being obvious over Moss et al. in view of Philips in view of Mochak and further in view of *In re Boesch*. Applicant respectfully traverses the rejection applied to the pending claims. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP 2143.03). As discussed above regarding the § 102 rejection, Moss et al. fails to teach or suggest an inner surface having an arc length that is greater than one-half the circumference of a cartridge disposed within the cylinder bores of the revolver. Combining Moss et al. with Philips and Mochak does not remedy this failure.

Furthermore, Applicant respectfully submits that the Examiner has misstated the holding of *In re Boesch*. The Court held "that discovery of an optimum value of a result effective variable *in a known process* is ordinarily within the skill of the art" (emphasis added). 205 USPQ 215, 219 (CCPA 1980). The Examiner has failed to show that finding an optimum angle for the beveled edge is a known process. Applicant submits that it is not a known process, and therefore, it would not be ordinarily within the skill of the art.

For the reasons given above, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

Conclusion

As Applicant has traversed each and every rejection raised by the Examiner, it is hereby respectfully requested that Examiner withdraw the rejections of claims 1-20 and pass claims 1-20 to issue.

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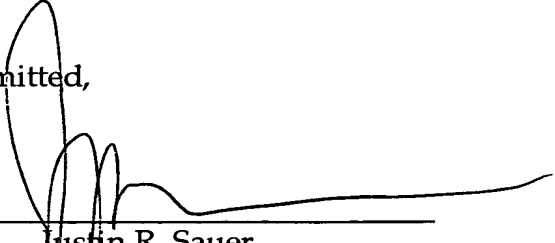
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If necessary, the Commissioner is hereby authorized in this reply to charge payment or credit any overpayment to Deposit Account No. 13-0235 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly, extension of time fees beyond those already authorized.

Do not hesitate to call Applicants' attorneys at the number below if they may help expedite the prosecution of this application in any way.

Respectfully submitted,

By



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